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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,045	05/01/2001	Philip Ted Kortum	8285/431	5221

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BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, IL 60611

EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/847,045

Applicant(s)

KORTUM, PHILIP TED

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, 5-7, 8-9, 12-15, 16-17 and 20 rejected under 35 U.S.C. 102(a) as being anticipated by “SBC global network DSL: Customer Self Install” (Document), which appears to be published on August, 2000.

The Document teaches customer self installation DSL kit and method of installing thereof, comprising:

As per claim 1,

- a digital subscriber line modem (page 4);
- at least one digital subscriber line filter (page 1);
- a computer-readable medium whose contents comprise computer-readable connection software code (pages 1, 5, 8 and 9);
- a set of instructions which describes a unified installation process for the digital subscriber line modem, the at least one digital subscriber line filter (pages 3 and 5);
- the computer-readable connection software code, wherein the unified installation process requires at most one operating system selection step by a user (pages 3 and 5).

As per claims 8 and 16,

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- a network card (page 4);
- a digital subscriber line modem (page 4);
- at least one digital subscriber line filter; (page 1);
- a computer-readable medium whose contents comprise computer-readable connection software code; (pages 1, 5, 8 and 9);
- an instruction manual which describes a unified installation process for the network card, the digital subscriber line modem, the at least one digital subscriber line filter, and the computer-readable connection software code, wherein the unified installation process requires at most one operating system selection step by a user (pages 3 and 5).

As per claims 2, 9 and 17, said kit and method, wherein the unified installation process described within the instruction manual requires no operating system selection step by the user (pages 5, 8 and 9).

As per claims 5-7, 12-15 and 20, said kit and method, wherein the instruction manual provides a point of contact telephone number associated with the digital subscriber line modem, the digital subscriber line filter or the computer-readable connection software code (pages 3, 5 and 10).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4, 10-11 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Document.

As per claims 3-4, 10-11 and 18-19, said Document teaches all the limitations of claims 3-4, 10-11 and 18-19, except for the container which contains said kit.

It would have been an obvious matter of design choice to modify the Document to include the container, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of the Document would perform the invention as claimed by the applicant with or without a container.

***Response to Arguments.***

Applicant's arguments filed 04/28/03 have been fully considered but they are not persuasive.

In response to applicant's argument that the Document fails to disclose selection of at most one operating system by a user, the examiner points out that the page 5 of the Document discloses a minimum computer requirements for the installation of the Kit including list of operating system, which inherently indicates that if the user selects not to choose any one of listed operating system, the user would not be able to successfully install the product.

In response to applicant's argument that the Document fails to disclose certain features of applicant's invention, it is noted that "a point of contact phone number" is disclosed on pages 3, 5 and 10; "the at least one digital subscriber line filter" is disclosed on page 1; "a digital subscriber line modem" is shown on page 4; "a computer-readable connection software code (pages 1, 5, 8 and 9); and "the network card" is shown on page 4 of the Document.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

***Conclusion***

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks  
Washington D.C. 20231***

or faxed to:

**(703) 305-7687** [Official communications; including  
After Final communications labeled  
"Box AF"]

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7<sup>th</sup> floor receptionist.

DB



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600